

THIS DECISION IS NOT  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Roberta C. Freiberg

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Serial No. 76388348

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Steven R. Petersen, Esq. for Roberta C. Freiberg.

Kelley L. Wells, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

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Before Drost, Zervas and Walsh, Administrative Trademark  
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Roberta C. Freiberg (applicant) filed an intent-to-use application on March 25, 2002, to register ALLERGY WIPES on the Principal Register for "disposable wipes." Applicant designated International Class 5 as the appropriate classification for her goods in her original application, and subsequently amended the identification of goods to "disposable eyelid wipes" and disclaimed "wipes."

The examining attorney has finally refused registration on the ground that the mark merely describes

the goods under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1). Additionally, the examining attorney has found the identification of goods "disposable eyelid wipes" indefinite, and has finally refused registration under Trademark Act § 1(b), 15 U.S.C. § 1051(b), in view of applicant's failure to amend the identification of goods further.

Applicant has appealed both refusals. Both applicant and the examining attorney have filed briefs. Applicant requested an oral hearing but later withdrew the request, and no oral hearing was held. For the reasons indicated below, we affirm both refusals.

The Requirement to Amend the Identification of Goods

The current amended identification of goods is "disposable eyelid wipes." The examining attorney has required applicant to amend further stating, "The identification is unacceptable because it is broad enough that it includes items that are classified in more than one class. The identification is not specific, clear and concise enough to determine the exact use of the goods and therefore the proper classification of the goods." The examining attorney offered the following as examples of identifications of goods in each of the potential international classes:

disposable eyelid wipes impregnated with chemicals or compounds for [indicate either personal hygiene or household use]; disposable eyelid wipes impregnated with eye makeup remover, in International Class 3;

disposable eyelid wipes premoistened with medication to treat allergy symptoms, in International Class 5;  
or

disposable eyelid wipes not impregnated with chemicals or compounds, in International Class 16.

Applicant has objected to this requirement, connecting her arguments regarding the requirement for a more definite identification of goods with her arguments against the descriptiveness refusal, "These are facially antithetical positions; if the Examiner cannot understand from the description what the goods are, how can the Examiner be so cocksure of how the mark describes the goods."

Applicant elaborates further:

In an intent-to-use application, an examiner lacks specimens in which an applicant might be caught explaining how a mark relates to the goods. . . . However, if an applicant can't be relied on to scuttle his own application with specimens, an examiner has another tool that may be applied toward that same end. An indefiniteness objection and requirement for the applicant to describe the goods and their uses in great detail might maneuver the applicant into ponying up evidence of descriptiveness for the examiner.

Later, applicant concludes her argument by reviewing the examining attorney's suggested identifications and stating,

Thus the only response to the final refusal that Applicant could rely on as acceptable was an amendment to describe the goods in a way the Examiner had

determined was merely described by the mark. The clarification requirement appears to have been a gambit to nail down a descriptiveness refusal.

First we fail to find any evidence of a "gambit" or other ulterior motive in the examining attorney's requirement for a more definite identification of goods. As we explain below, we would have no difficulty in affirming the descriptiveness refusal with or without the amended identification.

As to the identification requirement, we find it entirely reasonable. As the suggested identifications indicate, the goods as currently described could be classified in three different classes. Classes 3 and 5 appear to be most relevant. If the goods are impregnated with chemicals which are not medication, the goods would be classified as hygienic or cosmetic products in Class 3. If, on the other hand, the goods are impregnated with medication, the goods would be classified as pharmaceuticals in Class 5. The goods could also be simple tissues and classified as paper products in Class 16. See generally, 37 C.F.R. § 6.1.

We conclude that the examining attorney is simply trying to identify and classify applicant's goods suitably. A more definite identification is required to ensure that the goods are properly classified. In fact, proper

classification is very much in the interest of applicant in that republication of the application to correct the classification would be avoided, presuming the mark could be published in the first place. See Groening v. Missouri Botanical Garden, 59 USPQ2d 1601, 1603 (Com'r Pats. 2001) ("Where the mark was published with errors, the publication may be void, and a Notice of Allowance cannot be issued. Instead, the errors [in classification] must be corrected, and the mark republished.").

Although applicant disputes the examining attorney's authority to make such a requirement, we find applicant's position in error. Applicant does not dispute the U.S. Patent and Trademark Office's ("USPTO") statutory authority to require an identification of goods under Trademark Act §1(b), 15 U.S.C. § 1051(b); nor does applicant dispute the USPTO's statutory authority to classify goods and services under Trademark Act § 30, 15 U.S.C. § 1112. The dispute relates to the manner in which that authority has been exercised here.

The USPTO has significant discretion and the ultimate say in classifying goods. See Groening v. Missouri Botanical Garden, 59 USPQ2d at 1603. Cf. In re Tee-Pak, Inc., 164 USPQ 88, 89 (TTAB 1969). In fact, the examining attorney can change the class without authorization from

applicant. Groening v. Missouri Botanical Garden, 59 USPQ2d at 1603. The USPTO also has significant discretion in requiring a proper identification of goods. See Trademark Rule 2.32(a)(6). See, e.g., Trademark Manual of Examining Procedure ("TMEP") § 1402.05 (4<sup>th</sup> ed. 2005) and cases cited therein.

The issue here is the appropriateness of a requirement to amend an identification of goods which the examining attorney found too indefinite to permit classification. TMEP § 1402.03 sets forth guidelines governing such situations. It provides, in pertinent part:

(3) . . . However, the title of the class [class number] cannot be used to define the nature of the goods when the same item could be classified in more than one class depending on the material composition or field of use. For example, tools are classified in Class 7 if they are power-driven or Class 8 if they are not power-driven. The identification must indicate whether the tools must be classified in Class 7 or 8 (powered or nonpowered). In this situation the class title [number] cannot be used to justify the appropriate classification.

In this case the essence of applicant's argument is that she should not be required to amend the wording of the identification further because she has specified Class 5. Extending applicant's argument, Class 5 indicates that the goods are "medicated," so there is no need to say "medicated" or the equivalent in the identification. This is the precise situation this guideline addresses and

applicant's position is directly contrary to the cited TMEP section. We find the examining attorney's application of the guideline to this case entirely reasonable.

Applicants may not be familiar with the nuances of classification, especially in a case like this where the classification determination turns on arguably subtle distinctions. The USPTO bears the responsibility to get the classification right and cannot simply defer to the applicant in a case like this where there is a genuine ambiguity. Therefore, it was reasonable for the examining attorney to require more definite wording in the identification of goods so that the goods could be classified properly, in Class 5 or one of the other possible classes.

It is worth noting here that identification and classification of goods may be an administrative matter, but it is not a purely academic matter. It has a real impact on both the USPTO and the public. Both the USPTO and the public often use classification in conducting trademark searches of USPTO records. Furthermore, the USPTO must consider the identification of goods to determine whether goods are related in evaluating likelihood of confusion. If the identification of goods is not sufficiently definite to permit proper classification,

the USPTO's ability to determine likelihood of confusion may be affected.

Applicant characterizes the examining attorney's suggestions of specific identifications in this case as a sort of straightjacket she should not be forced to don. In reality the examining attorney merely posed a series of suggestions to accomplish the purpose of identifying and classifying the goods properly. Not all of the suggestions would lend support to the descriptiveness refusal; for example, "disposable eyelid wipes impregnated with eye makeup remover" would not. Also, applicant could have developed her own identification within that framework, or she could have furnished information regarding the intended composition and uses of the goods to enable the examining attorney to formulate further suggestions. Instead applicant took a hard line apparently out of a concern that she might reveal something about the goods which might not be helpful to her position on the descriptiveness refusal.

Accordingly, we affirm the examining attorney's requirement for a more definite identification of goods.

#### The Descriptiveness Refusal

We now turn to the refusal to register on the ground that the mark merely describes the goods under Trademark Act § 2(e)(1). A term is merely descriptive of goods



within the meaning of Trademark Act § 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods. See In re H.U.D.D.L.E., 216 USPQ 358, 359 (TTAB 1982); and In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods identified in the application, and the possible significance that the term would have to the average purchaser of the goods because of the manner of use or intended use. In re Polo International Inc., 51 USPQ2d 1061, 1062 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the

question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, e.g., In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1988) (SCREENWIPE generic for wipes that clean computer and television screens); In re Tower Tech, Inc., 64 USPQ2d 1314, 1318 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs). Furthermore, a mark need not describe the full scope of the applicant's goods to be found merely descriptive. In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371-72 (Fed. Cir. 2004).

Applicant begins her argument by stating, "The Examiner flatly asserts that 'applicant's goods are wipes which are used to treat or ease allergy symptoms.' There is no evidence of record that that is what applicant's

goods are."<sup>1</sup> Here and throughout her argument applicant scrupulously avoids disclosing the composition or purpose of the goods, but instead simply contends the goods are not what the examining attorney says they are. Nowhere does applicant assert that she does not know precisely what goods are or will be; nor has applicant explicitly denied that the goods could be used in connection with allergies.

Applicant argues further that the mark is suggestive, "The obvious way in which ALLERGY WIPES would be descriptive is if the purpose of the wipes were to wipe allergies, as the purpose of baby wipes is to wipe babies. Yet wiping allergies is a nonsensical notion . . . If a search for meaning beyond the obvious but nonsensical meaning occurs, it is a search for what the mark suggests . . . " Applicant continues, "A wipe is something intended for use in wiping. Wiping does not seem to be considered a useful process for treating or easing itchy watery eyes - in fact, wiping seems more likely to aggravate such allergy symptoms than to ease them."

In her reply brief, applicant adds the following to the argument: "All the examiner proffers is the opinion

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<sup>1</sup> We reject applicant's additional argument that the examining attorney has somehow amended the identification of goods without authorization by stating her argument in this manner.

that even the dullest consumer would, without using their imagination or taxing their brains in any way, 'immediately understand that eyelid wipes bearing the mark ALLERGY WIPES were used to treat or ease allergies.' While this does not quite clearly suggest the Examiner's view of how the undersigned's brains stack up against the dullest consumers' brain, it doesn't constitute evidence."

On the other hand, the examining attorney argues, as follows:

The term WIPES is defined as "Something, such as a towel or tissue used for wiping." (Footnote omitted) The applicant also uses the term WIPES to name or identify the goods. Previously submitted evidence from LEXIS/NEXIS established that allergy symptoms include itchy, watery eyes and also shows that drops or medications used to treat these symptoms are sometimes put in the eyes. The applicant's goods are identified broadly enough that they include a wipe used on the eyelids to treat or ease itchy, watery eyes or other symptoms. Use of the term ALLERGY with the generic term WIPES on the identified goods immediately conveys this function or purpose of the goods."<sup>2</sup>

We find the examining attorney's argument persuasive.

A 2003 excerpt from BIOTECH WEEK, included with the

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<sup>2</sup> In her brief the examining attorney references a definition for "wipes" from The American Heritage Dictionary of the English Language. Applicant has not objected. In any event, this dictionary definition is material as to which we can and do take judicial notice. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

examining attorney's evidence, states, "A new national survey reveals that itchy, watery eyes are the most annoying allergy symptom among common symptoms, including runny nose, sneezing, and scratchy throat." We conclude further that "watery eyes" can require wiping of the eyes and eyelids and that it is at least possible that wipes which are moistened or even medicated, goods within applicant's current broad identification, could alleviate symptoms.<sup>3</sup> Therefore, we conclude that the term ALLEGY WIPES, as applied to "disposable eyelid wipes" immediately conveys the purpose or function of the goods, i.e., that the wipes are for use in connection with allergies, and therefore, that applicant's mark is merely descriptive of the goods. There is no incongruity or imagination whatsoever in the combination of these terms.

We would reach this conclusion whether applicant's goods were classified in Class 3, 5 or 16. The current identification is broad enough to cover goods in any of these three classes, and ALLERGY WIPES would be merely descriptive of goods so identified in any of these classes. That is, any of the goods in these classes identified as

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<sup>3</sup> Applicant's contention that wiping of eyelids would aggravate rather than alleviate eye symptoms is not supported by any evidence.

"disposable eyelid wipes" could include "wipes" for use in connection with allergies.

In concluding so, we have considered all of applicant's arguments and find those arguments unpersuasive. In particular, we reject applicant's "baby-wipes" argument. That is, we reject applicant's argument that her mark differs from BABY WIPES, which is descriptive, and therefore, that her mark, ALLERGY WIPES, cannot be descriptive.

This argument requires us to assume that "wipes" can only be descriptive if it is combined with another term in the precise way "baby" and "wipes" are combined. Here and elsewhere applicant fails to recognize the nuances in language and the futility in attempting to adopt a rigid "rule" as to a particular term, regardless of context. Needless to say, we must decide each case on its unique facts. As the Court of Appeals for the Federal Circuit has observed, "In the complex world of etymology, connotation, syntax and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the

term." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). In fact, we find no essential difference between ALLERGY WIPES and BABY WIPES for purposes of Trademark Act § 2(e)(1). Each immediately conveys the function of the relevant product, though in slightly different ways.

This brings us to applicant's last principal and related line of argument, that is, that previous USPTO actions on a number of registrations dictate reversal of the refusal here. Applicant states, "The Trademark Office has issued numerous principal registrations for block-letter marks including WIPE formatives used in connection with wipe goods, where the marks are far more descriptive than the Examiner's conjecture regarding Applicant's goods." After discussing several of the registrations applicant states, "Stare decisis, equal protection, and due process require this agency to recognize and abide by the prior grant of rights and the body of decisional precedent it has created in the course of granting rights to other applicants, and to either treat this Applicant consistently or to overrule the law as it was applied in the precedents."

Applicant provided limited information regarding the third-party registrations, and no records related to those

registrations. The Board does not take judicial notice of registrations. In re JT Tobacconists, 59 USPQ2d 1080, 1081 n2 (TTAB 2001). In responding to applicant's arguments regarding prior registrations, the examining attorney did not object to the evidence, but she did provide full records related to two of the registrations, both on the Supplemental Register: Reg. No. 2682047 for SMOKERS WIPES for "pre-moistened napkin-size wipes saturated with different fragrances for cigarette smokers," in Class 3; and Reg. No. 2034648 for VET WIPES for "medicated premoistened tissues for veterinary use on the ears of dogs and cats," in Class 5. Although applicant herself had first offered these registrations in support of her position, now that the full records show that the marks are on the Supplemental Register, applicant discounts their importance. Of course, they do not support applicant's position.

In the case of the remainder of the registrations we have only limited information, the registration numbers, the marks and the goods, as reported by applicant. Consequently, among other things, we do not know whether the marks were registered based on a showing of acquired distinctiveness, whether terms are disclaimed, or for that matter whether any of these registrations are also on the



Supplemental Register. Due to the limited information provided, and for other reasons, these registrations are of limited probative value.

Furthermore, many of the marks in these registrations are obviously distinguishable from the mark at issue here, for example: Reg. No. 2293576 for SUNGUARD BODYWIPES for "wipes that contain suntan lotion"<sup>4</sup>; Reg. No. 2610731 for GONE WITH A WIPE for "premoistened cosmetic wipes impregnated with a skin cleanser"; Reg. No. 2027655 for LOVE-WIPES for "disposable human hygiene cleaning and deodorizing products, namely moistened wipes"; Reg. No. 2482804 for THE AFTERWIPE for "nonmedicated, premoistened towelettes for personal use and premoistened towelettes for cleaning"; Reg. No. 2565754 for SANIWIPE for "disposable wipes impregnated with sanitizers and disinfectants"; Reg. No. 1495099 for OPTI-WIPE for "lens tissues"; Reg. No. 1700539 for SMART WIPES for "paper towels"; Reg. No. 2044840 for WIPE-EZE for "all-purpose disinfectant towelettes impregnated with antiseptic cleaning solution"; and Reg. No. 1269905 for TIDY WIPES for "cleaning, dusting and polishing cloths." While we hesitate to characterize or categorize these marks, each is obviously

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<sup>4</sup> The marks and identifications provided here are those provided by applicant.

distinguishable from ALLERGY WIPES.<sup>5</sup> More importantly, as we indicated above, each case is unique and must be decided on its own merits. Id. Accordingly, we find applicant's evidence of third-party registrations unpersuasive.

**Decision:** We affirm the refusal to register on the ground that the mark is merely descriptive of the goods under Trademark Act § 2(e)(1) and the refusal based on the failure of applicant to amend the identification of goods, as required.

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<sup>5</sup> It is worth noting that the identifications of goods applicant references generally conform to the type of identification the examining attorney has required here.